

REMARKS

Claims 108-183 are now pending. Applicants have added claim 166, which was inadvertently omitted when claims 108-183 were added in the Response Under 37 C.F.R. § 1.111 filed on December 24, 2002.

Substitute Specification.

The Examiner indicates that a substitute specification was filed on January 6, 2003 (Office Action, Mar. 18, 2003, p. 2). Applicants have not filed any substitute specification. Applicants respectfully request that the Examiner provide applicants with a copy of the substitute specification.

Information Request

The Examiner has requested information under 37 C.F.R. § 1.105. In particular, the Examiner has requested the following:

1. a copy of a web page mentioned in the article entitled "Preliminary Injunction Lifted in 'One Click' Patent Battle,"
2. any prior art of record related to litigation concerning U.S. Patent No. 5,960,411 (the '411 patent), and
3. all summary court judgments and opinions related to litigation concerning the '411 patent.

Applicants are submitting an Information Disclosure Statement with the requested information. Applicants have reviewed its litigation files in response to this request. Applicants are providing copies of the prior art that was located during the review and that is not subject to a protective order of the Federal district court.

Double Patenting

The Examiner has rejected claims 108-165 and 167-183 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the

specification and claims of the '411 patent. Applicants respectfully traverse this rejection.

First, the Examiner errs in rejecting the claims over the "specification and claims" of the '411 patent. "When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art." (M.P.E.P. § 804 II.B.1., emphasis added.) Clearly, the Examiner is improperly rejecting the claims based on the disclosure (i.e., "specification") of the '411 patent, rather than just the claims of the '411 patent.

Second, the only basis that the Examiner provides for rejecting the claims is that "both [the application and the '411 patent] describe a method of making a purchase using a single action as opposed to using a shopping cart method, which normally requires and [sic, an] additional step of checkout." (Office Action, Mar. 18, 2003, pp. 3-4.) This basis does not even establish a *prima facie* case of obviousness-type double patenting. To establish a *prima facie* case, the Examiner is required to perform a factual inquiry that includes:

- (A) determining the scope and content of a patent claim and the prior art relative to a claim in the application at issue and
- (B) determining the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue.

(M.P.E.P. § 804 II.B.1.) The Examiner has performed neither of these factual inquiries. The Examiner has not pointed to any prior art in rejecting the claims based on obviousness-type double patenting. In addition, the Examiner has only pointed to the similarities of the claims, rather than the differences as required. Moreover, the Examiner has impermissively lumped together all the claims when each claim is clearly different from the claims of the '411 patent in different ways. For example, claim 108 is directed to not requiring a logon when ordering an item and requiring a logon when a

user updates their account information. Claim 126, in contrast, is directed to automatically combining orders into a single order.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 106-165 and 167-183 under 35 U.S.C. § 103 as being unpatentable over Blinn '373, Blinn '622, Yesil, Wojcik, and Official Notice. Applicants respectfully traverse these rejections.

Applicants respectfully request clarification of the facts for which the Examiner is taking Official Notice. Applicants can find nothing the Office Action to indicate the facts of which the Examiner is taking Official Notice. As such, applicants cannot effectively respond to the rejections. Even though an effective response is not possible without knowing the facts of which the Examiner is taking Official Notice, applicants make the following observations.

Claims 108-125, 151-157, and 176-183 are directed to not requiring a user to log on when ordering an item and requiring a user to log on when changing account information. The relied-upon references describe interacting with a server in an environment where the user logs on to the server whether placing an order or changing account information. Blinn '622 explicitly states that a "welcome.html page serves as a logon page for consumers." (Blinn '622, 7:53-67, emphasis added.) Blinn '373 describes that it uses the HTML templates as described in Blinn '622, which Blinn '373 incorporates by reference. (Blinn '373 13:59-14:6.) Blinn '373 further describes that it is preferred that "the layout of the initial welcome page [is defined] with a welcome.html template." (Blinn '373, 14:7-25.) Thus, both Blinn '373 and Blinn '622 describe an environment where users log on to the server before any other action is taken.

Yesil also describes systems in which a user is required to log on before taking any other action. Applicants are including in an Information Disclosure Statement additional pages from Yesil that illustrate this requirement. Yesil describes session-based tracking and subscription-based tracking of user information. Yesil describes

that a session for session-based tracking is "[o]ne customer's visit to an Internet Web site, from start to finish (login to logout)." (Yesil, p. 112, emphasis added.) According to Yesil, subscription-based tracking requires customer registration and retaining of knowledge of the customer between visits. "When logging on to shop, a [customer] can be authenticated and acknowledged." (Yesil, pp. 121-22, emphasis added.)

More generally, none of these references teaches or suggests that an item can be purchased without logging on to a server computer.

The Examiner recognizes that Blinn '373 "does not specifically teach that the order is placed in a single action." (Office Action, Mar. 18, 2003, p. 6.) To cure this deficiency, the Examiner relies on Yesil's description of the "instant buy button" of the Netscape Merchant System. The adding of the instant buy button, however, would not result in single-action ordering. Yesil only suggests that the "checkout review" step of the checkout process can be skipped. The checkout process involves more than just the step of reviewing items that have been placed in a shopping cart. It includes the steps of confirming (or providing) delivery information and payment information. Yesil does not suggest that these additional steps can be avoided with the use of the "instant buy button." Moreover, review of Netscape's Site Administrator's Handbook for the Merchant System under the heading "Instant Buy" states that the "customer can simply click on the Buy Now button, which brings up the Checkout page." (See, Appendix A). Thus, to actually place the order, the customer would need to click on the instant buy button and perform the actions required by the "Checkout page." As such the adding of the "instant buy button" to Blinn '373 would not result in single-action ordering.

The Examiner relies on Wojcik for teaching "optimizing shipment of multiple orders by consolidation." Wojcik, however, does not "combine" orders into a single order as recited by claims 126-139 and 158-167. Rather, Wojcik simply describes a technique for deciding which orders can be put on the same truck so that the truck will

be as fully loaded as possible. Regardless of what orders Wojcik decides to put on a truck, no orders are combined into a single order.

Claims 140-150 and 168-175 recite "displaying an indication that the order for the item that is requested can be canceled within a time interval," or similar language. The Examiner has not pointed to anything in the cited references as teaching, suggesting, or motivating such displaying. As such, the Examiner has not established a *prima facie* case that these claims are obvious.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 114-116, 134-136, 144-146, 173-174, and 181-182 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner believes that "the term 'partial' renders the claim indefinite since the whole is not distinctly defined. Applicants respectfully disagree. The specification clearly describes "partial" information. For example, partial information may include "the last five digits of a credit card number." (Specification, 11:13-27.) One skilled in the art would understand that the entire credit card number is the whole. The specification further states that "[s]uch partial information should be the minimum information sufficient to indicate to the purchaser whether or not the server system is using the correct purchaser-specific information." (Id.)

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
Art Unit No. 3625

Based upon these amendments and remarks, applicants respectfully request reconsideration of this application and its allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-8548.

Respectfully submitted,
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Additional Customer-Related Features

The Merchant System also provides a set of features for the customer who shops at the mall.

Customer Shopping Basket

The *Shopping Basket* keeps a tally of the products selected by the customer for purchase. It is local to the client on the customer's machine (i.e. a browser).

The MS updates the Shopping Basket as the customer adds and removes items in the Shopping Basket. The MS also provides a review of the contents, along with a description of each item selected. The Shopping Basket is Mall-wide in scope.

The Shopping Basket is time-stamped and emptied at selected intervals. The default is twelve hours after the Customer adds the first item to the Shopping Basket. The length of this interval is stated on the Review Shopping Basket screen.

The shopping basket is also emptied when a credit card transaction is rejected.

The contents of the Shopping Basket include the unique Stock Keeping Unit (SKU) number for each product and quantity requested. There is a unique SKU number for each product offered by the Mall. This uniqueness is preserved across Merchants, as in normal retail business practice.

The contents of the Shopping Basket are encrypted during its existence. This encrypted data can be read only by the Transaction Server and Merchant Server.

Instant Buy

Instant Buy enables one button shopping by means of a *Buy Now* button as part of the customer interface. The customer can simply click on the Buy Now button, which brings up the Checkout page. All items collected in the Shopping Basket up to that point are automatically purchased at that time.

The *Buy Now* button is a default in the *bud.mlc* template for each product. If the merchants want to disable this feature, they must change the *bud.mlc* template for that product by removing the template for the *Buy Now* button.

For instructions on how to configure the template, refer to the *Product Designer's Handbook*.

Pricing

As customers place products in their Shopping Baskets, the price of each product is entered in the Shopping Basket. When the Customer checks out of the Merchant System, the contents of the Shopping Basket are forwarded to the Transaction Server for processing.

The Merchant System supports the use of both product and SKU-level pricing, as well as sales prices for both product and SKU-level prices.

The action taken when the prices are not equal depends on the merchant price policy defined in the database.

Discounts and Coupons

This feature allows customers to add discount coupons to their shopping baskets and allows merchants to provide coupon information to the customers through a *coupon bud page*. Customers add coupons to their shopping basket from the product bud page. If the product has an associated coupon, customers can enter the coupon name in a window that is displayed on the product bud page. (Note that coupon names can be advertised, for example, in a newspaper or on the Internet.)

Product Search Module

Product search provides a configurable search engine used for locating storefronts and products on the Mall. The Product Search feature allows customers to enter keywords in a product search page and find products of their interest in the mall. This feature also enables "canned" search where customers can search for "Related products" in the mall. For information on the the Product Search module and its components, see "Product Search Module" on page 84.